

## REMARKS

Favorable reconsideration in view of the amendments and following remarks is respectfully requested. The Examiner is thanked for the examination of the application.

Claims 1-14 and 16-24 are pending. Currently, claims 14, 16-19 and 22-24 are under review, claims 1-13, 20 and 21 having been withdrawn as a result of the June 25, 2008 election of species requirement. Claims 14 and 22 are independent.

The Office Action rejects claims 14, 16, 17, 19, and 24 under 35 U.S.C. §103(a) over U.S. Patent No. 5,224,156, hereinafter *Fuller*, in view of U.S. Patent No. 7,068,384, hereinafter *Hou*. Claims 22 - 23 have been rejected under 35 USC 103(a) as being unpatentable over *Fuller*, in view of U.S. Patent No. 5,946,386, hereinafter *Rogers*. Claim 18 has been rejected under 35 USC 103(a) as being unpatentable over *Fuller*, in view of *Hou*, and further in view of U.S. Patent No. 6,825,955, hereinafter *Shibata*. These rejections are respectfully traversed.

In the non-limiting example disclosed in Applicant's published specification beginning at paragraph [0140], if a user of a receiver device, such as MFP 530, wants to receive faxes at a location other than MFP 530, the user notifies in advance each sender device, such as MFP 230, which is registered in the receiver device 530, of a destination to which send notifications should be sent, such as a mobile telephone 410, the user. In other words, MFP 530 notifies MFP 230 that send notifications should be sent to mobile telephone 410.

Then, if the user of the MFP 230 wants to send a fax to the MFP 530, the MFP 230 sends a send notification to the mobile telephone 410. The mobile

telephone 410 then responds to the MFP 230 with an address to which the fax should be sent.

Claim 14 corresponds to the MFP 230, although none of the claims herein are limited to the preferred disclosed embodiments. According to claim 14, a fax data transmission device comprises a first storing unit operable to store fax data and an identifier for identifying the fax data, in correspondence with each other. A second storing unit stores information showing a correspondence between an original destination of the fax data [such as MFP 530] and a send information destination [such as mobile telephone 410], the send information destination being a destination of send information. The send information includes the identifier and a notification that the fax data identified by the identifier is going to be sent.

A notifying unit sends the send information to the send information destination [such as mobile telephone 410] corresponding to the original destination [such as MFP 530] of the fax data, with reference to the information stored in the second storing unit. A receiving unit receives, as a reply to the send information, destination information from the send information destination [such as mobile telephone 410] specifying a destination to which the fax data should actually be sent. A sending unit then sends the fax data to the destination specified by the destination information that is extracted from the reply.

The notifying unit sends the send information via an Internet mail, and the receiving unit extracts the destination information from a mail replying to the Internet mail. However, the claims are not limited to the preferred disclosed embodiments.

*Fuller* discloses a method and apparatus for causing a message to be sent in facsimile compatible form over a telephone system from a first location to a second

remote location. The first memory 24 receives and stores an incoming fax message. A second memory 26 contains programmable access codes which are assigned to individuals and allows the individuals to access and retrieve messages stored in the first memory 24. See column 4, lines 3 - 27.

Once facsimile information is stored in the first memory 24, an individual is notified that a facsimile message has been received. *Fuller* discloses informing the recipient that a facsimile message has been received by having apparatus 60 call a telephone number and output a voice message, contact a pager or beeper, or call a remote facsimile machine and send a facsimile message to the recipient notifying that a facsimile message has been received. When the recipient has been notified that a facsimile message has been stored in his mailbox, the facsimile message may be retrieved by the user calling from a facsimile machine at a remote location and instructing the apparatus 60 to transmit the facsimile message immediately. The Office Action alleges that the first memory means 24 of *Fuller* corresponds to the claimed first storing unit, and that the second memory means 26 of *Fuller* corresponds to the claimed second storing unit.

Claim 14 further includes a receiving unit operable to receive as a reply to the send information, destination information from the send information destination for specifying a destination to which the fax data should actually be sent, and extract the destination information from the reply; and a sending unit operable to send the fax data to the destination specified by the extracted destination information; wherein the notifying unit sends the send information via an Internet mail, and the receiving unit extracts the destination information from a mail replying to the Internet mail. Thus, the process of receiving and extracting the destination to which the fax data

should actually be sent is done by means of internet mail. The Examiner acknowledges that this is not taught by *Fuller*. Instead, the Examiner relies upon the teachings of *Hou*. The Examiner alleges that *Hou* "...teaches the send information via an internet mail..." However, the send information, as used in claim 14, is defined as including an identifier for identifying the fax data stored in the first storing unit in correspondence with each other. The send information further includes a notification that the fax data identified by the identifier is going to be sent. Accordingly, although *Hou* may teach the use of internet mail, it clearly does not teach "***the send information*** via an internet mail", as that term is defined and used in claim 14. Furthermore, the Office Action has misinterpreted *Hou*. *Hou* does not teach sending a send notification by internet mail, *Hou* teaches sending the facsimile message itself by internet. Accordingly, the principles are completely different.

In addition, it is difficult to understand how the Examiner intends to combine an Internet mail system of *Hou* with the phone call required by the user in *Fuller*.

Therefore, *Hou* does not overcome the deficiencies of *Fuller* that are acknowledged by the Examiner. Claims 16, 17, 19, and 24 are patentable for similar reasons.

With regard to claims 22 - 23, the Examiner relies upon *Fuller* and *Rogers*.

Applicant's independent claim 22 is directed to a fax data transmission system comprising, in combination with other claimed features, a portable communication device including a third receiving unit operable to receive send information from a notifying unit in a fax data transmission device, when designated as the send information destination and a replying unit operable to send destination information to the fax data transmission device.

In *Fuller* there are two ways to receive the message remotely. One is to have a pre-stored remote facsimile number. The second is to call from a facsimile machine at a remote location and instruct the apparatus to transmit the facsimile message immediately on the same phone call. None of these provide the advantages of using, for example, a mobile telephone 410 and specifying a destination to which the fax should actually be sent. For example, the user may not be at a location that contains a facsimile machine and therefore, the user cannot immediately know if he has received a fax. Thus, the provision of the portable communication device in claim 22 provides advantages not realized by *Rogers* or *Fuller* either alone or in combination.

The Examiner acknowledges that *Fuller* does not teach a second receiving unit operable to receive destination information for specifying a destination to which the fax data should actually be sent, as a reply to the send information. Applicants respectfully disagree that *Rogers* overcomes this deficiency of *Fuller*.

*Rogers* relates to a call center for forwarding an ***already received fax message*** to another destination. According to the present claim 22, the second receiving unit receives destination information for specifying a destination to which the fax data should be sent, as a reply to the send information which was sent to a send information destination. Thus, the principles are very different.

Furthermore, in *Fuller*, the user calls from a facsimile machine at a remote location and instructs the apparatus to transmit the facsimile message on the same phone call. Thus, *Fuller* does not even contemplate the use of mail. In addition, no further information is provided as to the meaning of instructing the apparatus to transmit the facsimile message. In addition, it is difficult to understand how the

Examiner intends to combine an Internet mail system of *Rogers* with the phone call required by the user in *Fuller*.

Thus, claims 22 - 23 are distinguishable over *Fuller* and *Rogers* either alone or in combination.

The remaining claims are allowable for at least the reasons discussed above as well as for the individual features they recite. The *Shibata* reference does not overcome the deficiencies of *Fuller*, *Hou* and *Rogers* noted above.

Prompt and favorable examination on the merits is respectfully requested. Should any questions arise in connection with this application, or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: April 28, 2011

By: /WCRoland/  
William C. Rowland  
Registration No. 30888

**Customer No. 21839**  
703 836 6620